

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 5/30/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jack Groppel

Serial No. 74/636,932

Patrick R. Roche of Fay, Sharpe, Beall, Fagan, Minnich &
McKee for Jack Groppel.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Wendel and Holtzman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 17, 1995, Jack Groppel applied to register
the mark "CORPORATE ATHLETE" on the Principal Register for
"educational services; namely, conducting seminars and
workshops in the field of executive personnel and support,"
in Class 41, and "counseling services in the field of
executive personnel development and sport science," in

Class 42. Applicant claimed use of the mark in connection with these services since September 1, 1990.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that applicant's mark merely describes the services set forth in the application.

Applicant presented arguments that the mark is not merely descriptive of its services, but rather, at most, is suggestive of them.

The Examining Attorney was not persuaded, however, and in the second Office Action the refusal to register was made final. Attached to the final refusal were copies of a dictionary definition of the word "athlete" as "one who is trained or skilled in exercises, sports, or games requiring physical strength, agility, or stamina." The same dictionary defined "corporate" as "of or relating to a corporation," and "corporation" as "a body formed and authorized by law to act as a single person, although constituted by one or more persons, and legally endowed with various rights and duties including the capacity of succession."

Also attached to the final refusal were a number of excerpts from published articles, retrieved from the Nexis® database, wherein the term "corporate athlete" or its

plural form is used. Although a great number of excerpts were submitted with the Office Action, the following examples were apparently deemed the most probative by the Examining Attorney, because they were reiterated (in this order and manner) in his brief:

Not even a strong wind with a nippy bite to it stopped the corporate athletes or their families and friends from having a good time.

When they weren't hunkered under the company tents near the barbecue pits, the people walked...
Las Vegas Business Press, April 3, 1995

... sway to describe waves of stress and recovery. Chalices of 'carbobites,' or energy tablets, that sit on the seminar tables reinforce the image.

The corporate athlete is stressed emotionally and mentally. That's inescapable. The required recovery is physical exercise. The front office equivalent of the tennis match might unfold like this:
Fortune, November 28, 1994

... McEnroe, as well as the Chicago White Sox and countless other top athletes, will present his program on fitness for the corporate athlete in an installment of Sports System's Multi-Faceted Sports-Talk series.
Business Wire, April 29, 1994

The course will follow the West River Drive, beginning and ending at the Philadelphia Art Museum. More than 2500 corporate athletes, representing more than 122 companies, will compete...
PR Newswire, July 20, 1990

. ... at least a decade. But the ski classic, which begins Dec. 9 in Bear Valley, California, offers corporate athletes and 18-event circuit that concludes with national finals April 6 in Aspen, Colorado.
USA Today, November 30, 1989

... California, to participate in the world corporate games. This two-year-old event, planned as

a quasi-Olympics for the corporate athlete, started Saturday and continued through yesterday.
The New York Times, October 2, 1989

... Oct. 22 - Nov. 5, billed as the largest multi-sport corporate event ever held, will feature more than 10,000 corporate athletes competing in 20 sporting events around the Bay Area. Athletes will represent about 1900 corporations from 23...
Business Wire, October 13, 1988

Although some of the above-referenced excerpts plainly have no relevance to the issue before us in this appeal, it is fair to summarize the entire body of Nexis® evidence submitted by the Examining Attorney as demonstrating that the term sought to be registered is used in several different ways. The largest category of these excerpts show the term used in reference to athletes who compete in athletic competitions on behalf of the corporations by whom they are employed. Other examples show the term used to draw an analogy between businessmen (and business women) and athletes, with respect to the challenges and stresses, both emotional and physical, required to succeed in the competitive arenas of either business or sport. Additionally, several of the excerpts appear to make reference to applicant's own educational and consulting services, while a few others, also not cited in the Examining Attorney's appeal brief, appear to relate to particularly successful athletes who are compared to

corporations in terms of their collateral business activities.

Applicant filed a timely notice of appeal from the final refusal to register, along with a request for reconsideration. The Examining Attorney declined to change his position, so the appeal went forward. Both applicant and the Examining Attorney filed briefs, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

The only issue before us on appeal is whether the mark "CORPORATE ATHLETE" is merely descriptive of the educational services and counseling services specified in the application, within the meaning of Section 2(e)(1) of the Lanham Act. After careful consideration of the record and arguments before us, we hold that the refusal to register is not appropriate in this case.

The test for whether a trademark or service mark runs afoul of Section 2(e)(1) of the Act is not seriously disputed. A mark is unregistrable if it immediately and forthwith describes a quality, characteristic, function, feature, or purpose of the identified services. In *Re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

As noted above, applicant's services are set forth in the application as "educational services; namely,

conducting seminars and workshops in the field of executive personnel and support," and "counseling services in the field of executive personnel development and sports and science." The specimen of record, which appears to be an advertising brochure for applicant's services, provides additional insight into the programs and workshops offered by applicant. This advertisement makes it clear that applicant's services do not relate to training athletes who compete for corporations or to athletes whose business activities resemble those of corporations. Instead, applicant renders educational and counseling services related to executive personnel. Applicant's approach to improving business performance is to analogize corporate activity to athletic competition. Applicant provides an executive training program wherein the following topics, among others, are discussed: "Stress Management: Applying Sport Strategies to Business"; "Time Management: The Key to Productivity and Success"; "Peaking for That One Big Business Moment"; "Communication Techniques: The Keys to Success"; "Goal Setting For the Corporate Athlete"; and "Building Teamwork: Effective Management Techniques."

Plainly, the term sought to be registered is not merely descriptive of applicant's services. It is suggestive, in that the parallels between business

competition and athletic competition are emphasized, but the mark does not immediately convey, with any accuracy or specificity, any characteristic or feature of the services set forth in the application. Some thought process is required to make the analogy between actual athletes and people in business. This mental step makes the difference in this case between a term which is merely descriptive of the services and one which is only suggestive of them.

Another topic listed in applicant's advertising is "Training The Corporate Athlete," wherein the promotion of "day-to-day enthusiasm" and "recognizing strengths and weaknesses to reach peak levels of energy and productivity" are discussed, along with the role of fitness and nutrition in maintaining peak performance. Still other discussions relate to the importance of fitness and nutrition in relation to business and personal success.

The fact that health and fitness are discussed as part of applicant's educational and counseling services for businesspeople does not make "CORPORATE ATHLETE" merely descriptive of those services, even though "sport science" is mentioned at the end of the recitation of services in Class 42. Again, what makes this mark suggestive of these services, rather than merely descriptive of them, is that applicant's educational and counseling services are based

on an analysis of the parallels between athletic competition and business, but the services do not involve actual athletes who compete on behalf of corporations.

The Examining Attorney has not established that "CORPORATE ATHLETE" immediately conveys information about a feature, characteristic, quality, function, or purpose of applicant's educational and counseling services. Accordingly, the refusal to register based on Section 2(e)(1) of the Lanham Act is reversed.

R. F. Cissel

H. R. Wendel

T. E. Holtzman
Administrative Trademark Judges
Trademark Trial & Appeal Board

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